

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/805,695

Group Art Unit: 1794

Filed: March 22, 2004

Examiner: Steven N. Leff

Applicant: Paul V. Greco

Attorney Docket: Greco-001

Title: Weighted Infusion
Beverage Package

Commissioner for Patents
Alexandria, VA 22313

Sir:

APPLICANT'S BRIEF ON APPEAL

On January 9, 2008, the Examiner withdrew claims 6-9 from consideration and finally rejected claims 1-5 and 10-19. On April 9, 2008, the Applicant filed a Notice of Appeal (with fee) appealing the final rejection of claims 1-5 and claims 10-19. The present Brief on Appeal (with fee) is therefore timely. If any additional fee is due, please charge the fee to deposit account no. 07-1732.

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I. Real Party in Interest

The real parties in interest are Paul V. Greco and Mario Aieta, the inventors of the present application.

II. Related Appeals and Interferences

There are no other appeals or interferences which are related to this application or this appeal.

III. Status of the Claims

This application was filed with claims 1-20. Claims 6-9 have been cancelled. All remaining claims (claims 1-5 and 10-19) stand finally rejected. The final rejection of claims 1-5 and 10-19 was appealed on April 9, 2008. Therefore, claims 1-5 and 10-19 are the claims on appeal.

IV. Status of Amendments

No amendments were submitted after final rejection. Please refer to the Claims Appendix for the claims on appeal.

V. Summary of the Claimed Subject Matter

Independent claim 1 is directed to an infusion beverage package including a body portion (11 in Fig. 1) comprising overlying layers of porous material (12A, 12B in Figs. 1A, 1B) that are joined to form at least one compartment (18, 20, 22 in Fig. 1B) that carries an infusion beverage product 24 and a weight 26 (Fig. 1B) that is made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material. The porous material of the compartments allows water to pass through the compartments to infuse the beverage product with the water. The weight causes the body portion to sink in the water. This is generally described at page 6, line 6 through page 7, line 4 of the application. The advantages of this arrangement are described at page 9, lines 14-23.

Dependent claim 4 recites a first compartment distinct from a second compartment, the first compartment carrying infusion beverage product and the second compartment carrying the weight. This is generally described at page 6, line 22 through page 7, line 4 and Fig. 1B of the application. The advantages of this arrangement are described at page 9, lines 14-23.

Dependent claim 10 recites porous material including a sheet of fibrous cellulosic material. This is generally described at page 7, lines 6-9 of the application. The advantages of this arrangement are also described at page 7, lines 6-9.

Dependent claim 16 recites two body portions (11a', 11b' in Fig. 3) that extend from a hinged surface (34' in Fig. 3), and a bottom wall (36 in Fig. 3) extending between the two body portions such that the bottom wall and the two body portions define a space for solution to flow through during steeping, the bottom wall having a compartment (20' in Fig. 3) for carrying the weight. This is generally described at page 10, line 23 through page 11, line 5 of the application. The advantages of this arrangement are described at page 11, lines 8-15.

VI. Grounds of Rejection to be Reviewed on Appeal

The issues on appeal are:

- (1) whether claims 1-5, 10-13, and 18-19 are unpatentable under 35 U.S.C. §103(a) as obvious over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309) and in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004);
- (2) whether claim 14 is unpatentable under 35 U.S.C. §103(a) as obvious over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309), in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004), and in view of Luckhaupt (2193974); and
- (3) whether claims 15-17 are unpatentable under 35 U.S.C. §103(a) over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309), in view of the "Tea Rock" teabag weight (www.mightybeancoffee.com March 2004), and in view of Rambold (3542561).

VII. Argument

The Examiner's rejection of claim 1 on obviousness grounds under 35 U.S.C. §103(a) is improper because the combination of art cited by the Examiner was not predictable to one skilled in the art at the time of Applicant's invention. The Examiner's rejections under 35 U.S.C. §103(a) on obviousness grounds with respect to dependent claims 2-5 and 10-19 are improper because the dependent claims include all of the non-obvious limitations of claim 1, as well as additional features neither taught nor suggested by the cited art. As discussed below, the Examiner's rejections of all of Applicant's claims rest upon a plurality of references that teach away from Applicant's invention, and upon improper hindsight reasoning.

A. Claim 1 is patentable over the cited prior art.

Independent claim 1 is directed to an infusion beverage package that includes:

a body portion comprising overlying layers of **porous material** that are joined to form at least one compartment, **said at least one compartment carrying infusion beverage product in addition to a weight**, said porous material of said at least one compartment allowing for passage of water therethrough for infusion of said infusion beverage product carried in said at least one compartment and **said weight causing said body portion to sink in water, wherein said weight is realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material.**

When considering the obviousness of a combination of known elements, the operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___, 82 USPQ2d at 1396 (2007).

A.I. Arcari does not disclose a porous body portion carrying both infusion beverage product and a weight made from ceramic, porcelain, and/or naturally-occurring rock material as required by Claim 1.

Claim 1 requires a porous body portion having one or more compartments carrying both a weight and an infusion beverage product. Claim 1 also requires that the weight be realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material, and that the weight cause the body portion to sink in water. Arcari discloses detachable compartments in which flavoring, sweeteners, or other consumable and water-soluble materials may be disposed. Arcari does not teach, suggest, or make any mention whatsoever of a weight, let alone a weight made from a ceramic, porcelain, and/or naturally-occurring rock material disposed inside a porous compartment. Instead, Arcari discloses disposable compartments containing various infusion beverage products (such as dried tea leaves, ground coffee beans, dehydrated powdered tea, and flavoring material such as dried milk powder or sugar granules), all of which are detachable either from a spine portion or from commonly sealed perforated edges so that the various products in the compartments can be discarded prior to placing the beverage pack in a liquid. Therefore, **Arcari teaches away from using a weight realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material, the weight disposed inside at least one compartment of a porous body in addition to infusion beverage product** as required by claim 1.

In the Final Office Action dated January 9, 2008, the Examiner rejects claim 1 stating that Arcari teaches a "weight" that causes a body portion to sink in water, and

points to page 4, line 6 of Arcari to purportedly support this statement. Applicant submits that this assertion is a misrepresentation of Arcari. As discussed above, the disclosure in page 4 of Arcari discusses multiple detachable compartments of a unit beverage pack in which coffee, tea, milk, and sugar are retained in their dry state prior to being introduced into water to form a beverage to the desired taste of the consumer. The word "weight" does not appear on page 4 or anywhere in the entire Arcari disclosure, nor does the concept of weighing down the beverage pack. Yet the Examiner states that Arcari teaches, "in addition" to the infusion beverage product of coffee, tea, or milk product, "a weight that causes said body portion to sink in water" (Final Office Action, page 2, lines 4-5 of first paragraph of 103(a) rejection). The Examiner also states that a second compartment of the Arcari beverage pack carries a weight (Final Office Action, page 2, lines 10-11 of first paragraph of 103(a) rejection).

This mischaracterization of Arcari was first introduced in the second Office Action dated July 23, 2007 in which the Examiner recited the exact same argument, but admitted that the "weight" in Arcari is taken to be "the weight of the bag material itself in addition to the contents after the contents have absorbed an amount of water which in turn causes the bag to sink" (see Office Action dated July 23, 2007, last three lines of page 3). This statement is unsupported by the disclosure of Arcari. Moreover, and as further discussed below with regard to Kasket, infusion beverage product often causes a tea bag to rise in a liquid beverage, not sink. The Examiner's convenient use of the word "weight" to describe the contents of the unit beverage pack once it is wet is merely an attempt to ascribe to the Examiner's primary reference an element that is simply not there.

After accepting this false premise, the Examiner then concludes that the only limitation in Applicant's claim 1 not taught by Arcari is the material from which the "weight" is made.

Arcari does not contain any reference to a weight, let alone one that causes the body portion to sink in water or one that is made from a particular material. The Examiner compounds the mischaracterization in both the second and Final Office Actions by stating that Arcari teaches a second compartment, distinct from the first compartment, that carries a "weight" made from a dissolvable sweetener such as sugar. Arcari discloses no such thing. Again, the Examiner's reference to page 4, line 7 of Acrari merely discloses sugar disposed in a detachable compartment of a unit beverage pack. Arcari fails to teach or suggest one or more compartments of a porous body that carry both a weight and an infusion beverage product. Therefore, all of the Examiner's rejections under 35 U.S.C. §103(a) require the importation into Acari of a porous body with at least one compartment that carries both the weight **and** infusion beverage product as well as the limitation that the weight be made from the group consisting of ceramic material, porcelain material, and naturally occurring rock material (as admitted by the Examiner) as required by claim 1.

A.II. Kasket employs a weight as part of a beverage pack in a manner that teaches away from the claimed combination.

Claim 1 requires a porous body portion having one or more compartments carrying both a weight and an infusion beverage product. The Examiner asserts that it would have been obvious for one skilled in art to incorporate the weight disclosed in Kasket and incorporate it into the invention of Arcari. Kasket teaches a weight made from **metal** that is preferably placed in a **non-porous** pouch 7 that is separately attached

to a stick 10 connected to the beverage packet. **By attaching the weight to either the bottom of the stick 10 or to a separate "non-porous" plastic pouch 7, neither of which is a part of the same porous body carrying the infusion beverage product, Kasket teaches away from providing the weight in addition to the infusion beverage product in at least one compartment of a porous body as required by claim 1. In addition, by using a metal weight, Kasket teaches away from using a weight realized from ceramic material, porcelain material, and naturally-occurring rock material as required by claim 1.**

In the Final Office action, the Examiner proposes that Kasket discloses two kinds of weights - one which is purportedly formed from the water contacting the infusion substances, and the other consisting of a non-toxic, insoluble material separate from the infusion substances. The Examiner cites Col. 1, lines 23-30 of Kasket as allegedly supporting this statement and contends that the statement supports combining Arcari and Kasket. These statements mischaracterize the disclosure of Kasket, which, as discussed above, actually teaches away from a combination with Arcari. The additional portions of Kasket cited by the Examiner (Col. 1, lines 23-30) summarize the beverage package disclosed therein, which remains fully immersed in the infusion liquid and resists any tendency to float by virtue of a **liquid pocket** or a **weighted handle**. As Kasket achieves the liquid pocket or weighted handle by attaching a metal weight 13 to a stick 10 with a separate **non-porous** plastic pouch 7, Kasket teaches away from the configuration of claim 1. Moreover, the liquid pocket and weighted handle of Kasket help to keep the beverage package fully immersed in the infusion liquid, which otherwise:

"has a tendency to rise up in the cup due to captured air bubbles and the light density of the materials within the bag...thus preventing effective infusion of the beverage in the soluble base." (Col. 1, lines 23-30).

Thus, the very portion of Kasket cited by the Examiner discusses the fact that infusion beverage material does not act as a weight when combined with water, but in fact does just the opposite, and causes floatation by virtue of its light density and its tendency to capture air bubbles when placed in water. This language refutes the Examiner's argument that both Arcari and Kasket disclose a "weight" in the form of wetted infusion beverage product. Moreover, and as discussed above, **neither Arcari nor Kasket teach or suggest the claimed combination of a porous body portion having one or more compartments for carrying both a weight and an infusion beverage product.**

The Examiner also states, on page 4 of the Final Office Action that it would have been obvious to combine Arcari and Kasket because providing the non-toxic and insoluble material directly within the compartment which houses the infusion product would allow for:

"an overall reduction in the amount of material required due to the fact that only a single body portion is needed to house both the substance and a weight since the weight is non-toxic, and therefore would not harm the consumer and thus subsequently decrease the overall cost of the product since the amount of needed material is reduced. In addition, by providing the weight within the same body, the package becomes a one-time use package and thus increases the number of overall sales since the weight may not be re-used."

These statements by the Examiner are merely speculation and constitute improper hindsight reasoning. The fact that Applicant's invention poses benefits to a manufacturer and/or seller speaks to its utility, and the fact that, as discussed below, the Examiner required four references to purportedly disclose the elements in Applicant's claim 1 despite tea bags having been around for nearly one hundred years speaks to the novelty of

Applicant's invention. Taking the benefits of Applicant's invention and using those benefits to procure an obviousness rejection that requires four references to purportedly show the elements of the claim is not in the spirit of *KSR*.

A.III. Kim discloses a fishing weight that is used in a manner that teaches away from the claimed combination.

Kim does not teach or suggest placing both a ceramic weight and infusion beverage product into at least one compartment of a porous body of an infusion beverage package as required by claim 1. Instead, Kim teaches a method for manufacturing a fishing weight from a ceramic material. The weight disclosed in Kim, like most fishing weights, facilitates casting a fishing line and fishhook into the water. Such a mechanism generally requires that the weight be disposed separately or offset from the hook, and that the hook be supported by a buoyant float as described in the background section of Kim. Thus, Kim teaches away from placing the weight inside of at least one compartment of a porous body of any product, let alone an infusion beverage package as required by claim 1.

In rejecting claim 1, the Examiner contends that it would have been obvious to replace the metal weight of Kasket with the ceramic weight of Kim. However, Kim does not teach or suggest any applications outside of fishing, let alone placing the ceramic weight in at least one porous compartment with infusion beverage product as required by claim 1. The Examiner is combining a reference that teaches specific steps for molding a specific kind of fishing weight with references relating to the creation or design of teabags or beverage package designs. The use of ceramic materials to allow fishermen to cast their

lures and bait into the ocean without polluting the environment has nothing to do with tea bags or any beverage related product. Moreover, and as discussed above, both Kim and Kasket teach away from placing a weight inside of at least one compartment of a porous body as required by claim 1, and Arcari does not teach the use of a weight at all.

A.IV. The "Tea Rock" weight is also used in a manner that teaches away from the claimed combination.

The cited Tea Rock weight does not teach or suggest placing both a ceramic weight and infusion beverage product into at least one compartment of a porous body as required by claim 1. Instead, the Tea Rock teabag weight is attached externally to the teabag via a string that twists around a notch in the stone weight. The weight in this reference is also disposed externally from the teabag. It is not contained within at least one porous compartment in addition to infusion beverage product as required by claim 1. By disclosing an externally attached and discardable weight, the Tea Rock teabag teaches away from the limitations of claim 1.

Applicant notes the recent finding of the U.S. Supreme Court that inventions, in most instances, rely upon building blocks long since uncovered, and that claimed discoveries almost of necessity will be combinations of what is already known. *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___, (2007). Given the existence of teabags for approximately the last one hundred years, the fact that the Examiner needed **four different references** to allegedly make out a *prima facie* case of obviousness under 35 U.S.C. §103(a) for a claim that is relatively simple and straightforward and does not contain excessive or redundant elements, but rather, contains a limited number of elements, all of which have utility - these facts are clear evidence of nonobviousness.

Despite the apparent simplicity of Applicant's invention, every invention is arrived at in part through using known devices and knowledge to produce something that is unknown.

It is often the simple ideas that can revolutionize the art or at the very least make businesses and methods more profitable and efficient. This is the spirit of the patent law, and the Applicant submits that the Board should reward Applicant's ingenuity, not refuse to grant property rights on an invention that has taken four references, all of which teach away from Applicant's invention, to purportedly make a *prima facie* case of obviousness.

Therefore, the cited prior art, alone and any combination thereof, fails to teach or suggest important limitations of claim 1, and that the Board should find that claim 1 is patentable over the cited prior art.

B. The dependent claims of the present application are patentable over the cited prior art.

B.I. Claims 2-3

Dependent claims 2-3 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectively depend.

B.II. Claim 4

Dependent claim 4 is patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which it depends and for reciting additional features that are neither taught nor suggested by the prior art.

Specifically, claim 4 contains the additional limitation that the porous body portion includes distinct first and second compartments, one of which carries an infusion beverage product and the other of which carries the weight (as opposed to the infusion beverage product and the weight being carried within the same compartment). The cited art does not teach or suggest a porous body carrying a weight realized from ceramic, porcelain, or naturally occurring rock material in one compartment, and infusion beverage product in another distinct compartment. Therefore, claim 4 is patentable over the cited art.

B.III. Claim 5

Dependent claim 5 is patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which it depends.

B.IV. Claim 10

Dependent claim 10 is patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which it depends and for reciting additional features that are neither taught nor suggested by the prior art. Specifically, claim 10 contains the additional limitation that the porous material of the body portion of the infusion beverage package includes a sheet of fibrous cellulosic material. The Examiner, on page four of the first office action dated February 8, 2007, stated that Kasket teaches that the envelope is made of porous paper mats "where paper is made from cellulose," citing page 2, column 1, line 5 of Kasket. The Kasket reference to the envelope is actually in column 2, line 5, and it does not contain any reference to the

paper being made from cellulose. This particular section of Kasket simply states that porous plastics can be used for certain granulated or powdered substances. Therefore, the Examiner has failed to provide a proper *prima facie* rejection of claim 10.

B.V. Claims 11-15

Dependent claims 11-15 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectively depend.

B.VI. Claim 16

Dependent claim 16 is patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which it depends, and for reciting additional features that are neither taught nor suggested by the prior art. Specifically, claim 16 contains the additional limitations that the infusion beverage package include two body portions that extend from a hinged surface, and a bottom wall extending between the two body portions to define a space for solution to flow through during steeping. Claim 16 also requires that the bottom wall have a compartment for carrying the weight. Nowhere does the cited prior art teach or suggest this feature. The Examiner points to a **fifth** reference (Rambold) as suggesting these features. However, Rambold does not contain any teaching or suggestion of carrying a weight in a bottom compartment that extends between the two body portions extending from a hinged interface (nor does Kasket or any of the other cited art). The Examiner states on page 6 of the Final Office action that one of ordinary skill in the art would have been motivated

to combine the teachings of Kasket and Rambold "in order to produce an infusion beverage package which is capable of being more easily and compactly packed for distribution, thus decreasing the overall size of the package and increasing the number of packages in a given area due to the body portions by being folded together into a relatively flat condition as Rambold teaches." Not only is this statement improper hindsight reasoning, but that it expresses functional improvements that have nothing to do with those obtained from providing a bottom wall carrying a weight that extends between two body portions, among which are improving the steeping of the teabag as well as providing increased infusion surface area. Therefore, it is clear that that the cited prior art fails to teach or suggest important limitations of claim 16. For these reasons, claim 16 is patentable over the cited prior art.

B.VII Claims 17-19

Dependent claims 17-19 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectively depend.

In light of all of the above, it is submitted that the claims are in order for allowance, and the applicant respectfully requests that the Board direct the Examiner to allow the case.

Respectfully submitted,



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May 13, 2008

VIII. Claims Appendix

1. An infusion beverage package comprising:

a body portion comprising overlying layers of porous material that are joined to form at least one compartment, said at least one compartment carrying infusion beverage product in addition to a weight, said porous material of said at least one compartment allowing for passage of water therethrough for infusion of said infusion beverage product carried in said at least one compartment and said weight causing said body portion to sink in water, wherein said weight is realized from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material.

2. An infusion beverage package according to claim 1, wherein:

said at least one compartment carries an agent that imparts flavor into a solution during steeping of said infusion beverage product.

3. An infusion beverage package according to claim 1, wherein:

said overlying layers of porous material are joined together by one of thermal welding, compression, folding or stitching to form said at least one compartment.

4. An infusion beverage package according to claim 1, wherein:

said at least one compartment comprises a first compartment distinct from a second compartment, said first compartment carrying infusion beverage product and said second compartment carrying said weight.

5. An infusion beverage package according to claim 1, wherein:

said weight comprises a material that is non-toxic, insoluble, odorless and flavorless.

6 - 9 (cancelled)

10. An infusion beverage package according to claim 1, wherein:

said porous material comprises a sheet of fibrous cellulosic material.

11. An infusion beverage package according to claim 1, wherein:

said porous material withstands immersion into boiling water without damage or disintegration in addition to being non-toxic, odorless and flavorless.

12. An infusion beverage package according to claim 2, wherein:

said agent is selected from the group consisting of sugar and a sugar substitute.

13. An infusion beverage package according to claim 1, further comprising:

a string having a first end opposite a second end, wherein the first end is anchored to said body portion; and

a tag affixed to said second end of said string.

14. An infusion beverage package according to claim 13, wherein:

said tag carries product indicia.

15. An infusion beverage package according to claim 1, further comprising:
 - two body portions that extend from a hinged interface.
16. An infusion beverage package according to claim 15, further comprising:
 - a bottom wall that extends between the two body portions, said bottom wall and two body portions defining a space for solution to flow through during steeping, and wherein said bottom wall has a compartment for carrying said weight.
17. An infusion beverage package according to claim 16, wherein:
 - said bottom wall is foldable.
18. An infusion beverage package according to claim 1, wherein:
 - said infusion beverage product is selected from the group consisting of tea and coffee.
19. An infusion beverage package according to claim 1, wherein:
 - said infusion beverage product is selected from the group consisting of soups, powdered milk, medicinal preparations, food seasonings, and dyes.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.